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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|-----------------------------|------------------|
| 10/829,579 | 04/22/2004 | Mazen Faraj | CA920030072US1 | 6716 |
| 25259 7590 01/11/2007 IBM CORPORATION 3039 CORNWALLIS RD. DEPT. T81 / B503, PO BOX 12195 REASEARCH TRIANGLE PARK, NC 27709 | | | EXAMINER BIBBEE, JARED M | |
| | | | ART UNIT 2169 | PAPER NUMBER |
| SHORTENED STATUTORY PERIOD OF RESPONSE | | MAIL DATE | DELIVERY MODE | |
| 3 MONTHS | | 01/11/2007 | PAPER | |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/829,579

Applicant(s)

FARAJ, MAZEN

Examiner

Jared M. Bibbee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in Application No. 10/829,579, filed on 4/22/2004.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

With respect to claims 1, 9, and 15 it is clear that the claim language simply represents an abstract idea where the storing, in a property file, property keys and their associated resource property values, but fails to provide a useful, concrete, and tangible purpose or result. Applicant is reminded that patent protection is limited to inventions that possess a certain level of "real world" value, as opposed to subject matter that represents nothing more than an idea or concept (*Brenner v. Manson*, 383 U.S. 519, 528-36, 148 USPQ 689, 693-96 (1966)); *In re Fisher*, 421 F.3d 1365, 76 USPQ2d 1225 (Fed. Cir. 2005); *In re Ziegler*, 992 F.2d 1197, 1200-03, 26 USPQ2d 1600, 1603-06 (Fed. Cir. 1993)).

Since the claims presented by the applicant are indeed simply abstract ideas, the claims are not covered by the statutory categories of patentable subject matter set forth in 35 U.S.C. 101. An abstract idea is categorized as one of the three judicially created exceptions to patentable subject matter (the three exceptions are Laws of Nature, Natural Phenomena, and

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Abstract Ideas). The courts have concluded that in order to patent on of the three judicial exceptions to the statutory categories of the invention the claimed subject matter must have a practical, real-world application that produces a useful, concrete, and tangible result (*State Street*, 149 F.3d at 1373-74, 47 USPQ2d at 1601-02).

In order to overcome this rejection, the applicant must add a final limitation to independent claims 1, 9, and 15 showing a step of actually presenting the property file to a user in the form of a view. By adding this conclusionary step, the applicant will add to the claimed invention a useful, concrete, and tangible result that arises from a practical application of the method steps previously mentioned in the claim.

Claims 2-8, 10-14, and 16-20 are rejected because they contain the deficiencies of claims 1, 9, and 15 respectively.

Additionally with respect to claim 15, the claim is rejected under 35 U.S.C. 101 because it also appears that the computer readable medium that is claimed by the applicant is not limited to physical articles or objects, which are structurally and functionally interrelated to the instructions in such a manner that would enable the instructions to act as a computer component and realize any functionality. On page 18, paragraph [0029], the applicant states that the computer readable medium for which the program of the invention can be embodied includes any mechanism for storing or transmitting information in a form readable by a computer. The applicant further states, in paragraph [0030], that the computer readable medium includes a "signal-bearing medium (e.g., carrier waves, infrared signals, digital signals, etc.)". This type of computer readable medium is not limited to media, which meet the criteria set forth above.

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Appropriate clarification and/or correction is required. It is noted that in this instance, Applicant's specification clearly distinguishes between media, which "store" versus communications media, which would "convey" the program. Therefore, an amendment to the claims to recite a 'physical computer readable storage medium' rather than 'computer readable medium' would be favorably considered.

Claims 16-20 are rejected because they contain the deficiencies of claim 15 respectively.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 5, 13, and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 recites the limitation "property key name" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 13 recites the limitation "property key name" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 19 recites the limitation "property key name" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Warshavsky et al (U.S. 6,732,095 B1).

With respect to independent claim 1, Warshavsky clearly teaches in a team sharing environment, an integrated development environment for persisting resource properties during transitions of data between a user and a team repository (*see column 4, lines 38-56*), the integrated development environment comprising:

- a property file for storing property keys and their associated resource property values (*see column 5, lines 4-30 and Tables 1-3; Note the property keys are the items listed under property name in Table 1-3 and the property values is the data that resides in those fields.*).

With respect to dependent claim 2, note the discussion of claim 1 above, Warshavsky discloses all of the elements of claim 1 and further teaches the limitation of an associated property file is created for each resource having properties to be persisted (*see column 7, lines 49-58*).

With respect to dependent claim 3, note the discussion of claim 1 above, Warshavsky discloses all of the elements of claim 1 and further teaches the limitation of the property file is further used for storing a cache of prior resource property values (*see column 7, lines 49-58; The prior resource property values are the values located in the DTD file.*).

With respect to dependent claim 4, note the discussion of claim 1 above, Warshavsky discloses all of the elements of claim 1 and further teaches the limitation of the property file is

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searchable for returning a list of the property keys and their associated resource property values
(see column 8, lines 9-29).

With respect to dependent claim 5, note the discussion of claim 1 above, Warshavsky discloses all of the elements of claim 1 and further teaches the limitation of the property key name is qualified by appending the property key name to the name of the contributing resource
(see column 7, lines 1-32).

With respect to dependent claim 6, note the discussion of claim 1 above, Warshavsky discloses all of the elements of claim 1 and further teaches the limitation of the property file is a metadata file (see column 7, lines 49-58; Note that the XML Mapping Definitions are stored in a repository indicating that the definitions are metadata.).

With respect to dependent claim 7, note the discussion of claim 6 above, Warshavsky discloses all of the elements of claim 6 and further teaches the limitation of the metadata file is an XML file (see column 8, lines 30-37).

With respect to independent claim 9, claim 9 is a method claim corresponding to environment claim 1 and is rejected for the same reasons as set forth in the rejection of claim 1 above.

With respect to dependent claim 10, note the discussion of claim 9 above, Warshavsky discloses all of the elements of claim 9 and further teaches the limitation of storing the property keys and values in different property files for different resources (see column 7, lines 49-67 through column 8, lines 1-30).

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With respect to claims 11-13, claims 11-13 are method claims corresponding to environment claims 3-5 and are rejected for the same reasons as set forth in the rejection of claims 3-5 above.

With respect to independent claim 15, claim 15 only differs from claim 1 in that it adds to the preamble the limitation of a computer program product having a computer readable medium tangibly embodying computer executable code. Warshavsky clearly teaches a computer program product having a computer readable medium tangibly embodying computer executable code (*see column 3, lines 14-27*). As for the rest of claim 15, it corresponds to claim 1 and is rejected for the same reasons as set forth in the rejection of claim 1 above.

With respect to dependent claim 16, note the discussion of claim 15 above, Warshavsky discloses all of the elements of claim 15 and further teaches the limitation of code storing the property keys and values in different property files for different resources (*see column 7, lines 49-67 through column 8, lines 1-30*).

With respect to claims 17-19, claims 17-19 are computer program product claims corresponding to environment claims 3-5 and are rejected for the same reasons as set forth in the rejection of claims 3-5 above.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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9. Claims 8, 14, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Warshavsky et al in view of Bradley et al (U.S. 6,584,507 B1).

With respect to dependent claim 8, note the discussion of claim 1 above, Warshavsky discloses all of the elements of claim 1, but fails to explicitly recite providing an extension point for providing an application program interface to third party plug-ins for creating a property file for the third party plug-in. However, Bradley clearly teaches providing an extension point for providing an application program interface to third party plug-ins for creating a property file for the third party plug-in (*see column 10, lines 25-67 through column 12, lines 1-15*).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the mapping between XML documents and relational data as taught by Warshavsky to incorporate the ability to add additional applications (XML document or based web applications) as taught by Bradley for the purpose of allowing users to add third-party applications to a network of already established applications. The skilled artisan would have been motivated to modify the mapping between XML documents and relational data as taught by Warshavsky to incorporate the ability to add additional applications (XML document or based web applications) as taught by Bradley for the purpose of minimizing engineering and support effort required to integrate applications and make them operate together (*see column 5, lines 53-67*).

With respect to independent claim 14, claim 14 is a method claim corresponding to environment claim 8 and is rejected for the same reasons as set forth in the rejection of claim 8 above.

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With respect to independent claim 20, claim 20 is a computer program product claim corresponding to environment claim 8 and is rejected for the same reasons as set forth in the rejection of claim 8 above.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Coulthard et al (U.S. 2004/0003371 A1) is cited to teach a framework to access a remote system from an integrated development environment.

Li (U.S. 2004/0054675 A1) is cited to teach a data management system having a common database infrastructure.

Carter et al (U.S. 5,987,506) is cited to teach a remote access and geographically distributed computers in a globally addressable storage environment.

Sarkar (U.S. 6,418,448 B1) is cited to teach a method and apparatus for processing markup language specifications for data and metadata used inside multiple related internet documents to navigate, query and manipulate information from a plurality of object relational databases over the web.

Inquiries

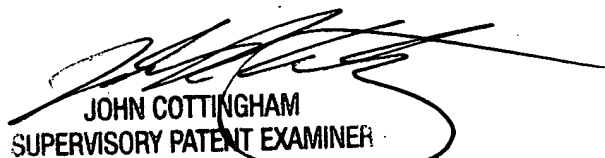
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jared M. Bibbee whose telephone number is 571-270-1054. The examiner can normally be reached on IFP.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christian Chace can be reached on 571-272-4190. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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